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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,529	03/08/2002	Mie Matsuo	04329.2763	8900

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Finnegan, Henderson, Farabow,
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Washington, DC 20005-3315

EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,529

Applicant(s)

MATSUO ET AL.

Examiner

James A. Kramer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15 and 17-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6, 7, 22, 8, 10, 13, 14, 23, 15, 17, 20 and 24 are rejected under 35 U.S.C.

103(a) as being unpatentable over Ray in view of Applicant's disclosure.

Ray teaches a system and method for the selection of heating equipment. Specifically, Ray prompts the user through display images for necessary information (column 3; lines 44-46). Examiner notes that this represents prompting a buyer to input a specification of the product the buyer wants to buy.

Ray then uses the information specification information input by the user to display a list of equipment options by general product line for the user's consideration (column 6; lines 30-31). Examiner notes that this represents extracting the electronic product which meets the specification of the product from a database.

Ray further teaches a program that determines an estimated annual energy cost for various types of heating options satisfying the heat loss value previously calculated (based on user input specification) (column 6; lines 15-19). Examiner notes that these calculations represent performance data and thus also represents a simulating a condition for manufacturing.

Ray also teaches prompting the user to select an product from a list to meet or exceed the total heat loss value (column 6; lines 40-43). Examiner notes that this represents providing the

Art Unit: 3627

expected buyer with conditions for manufacturing and prompting the user to answer if the condition is satisfied (i.e. if it is satisfied the user selects the product).

Examiner notes that Ray does not teach an electronic product, namely a semiconductor nor that the simulation relates to the performance of the semiconductor. However, in the background section of the Specification, Applicant teaches simulation of performance of electronic equipment is old and well known, but costly to implement. Examiner thus notes that It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system for the selection of heating equipment as taught by Ray to include the selection of electronic components by including in the database of heating performance data, simulation data on semiconductors as taught by Applicant in order to help users select electronic equipment.

Claims 4, 5, 25, 26, 30, 11, 12, 27, 28, 31, 18, 19, 29, 32 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudle et al. in view of Applicant's disclosure.

Dudle et al. teaches a custom product estimating and order processing system. Specifically, a sales site computer facilitates the entry of design parameters and estimate parameters to obtain estimate data from a manufacturer's corporate office (column 3; lines 59-64). Examiner notes that this relates to prompting a buyer to input a specification of a product.

Dudle et al further teaches a computer and database at the manufacturer's corporate office for storing price tables and calculating costs and/or list price estimates based on the tables and the item specifications and estimate parameters entered by the customer (column 4; lines 8-14). Examiner notes that this relates to extracting the product that meets the specifications from a database, outputting that information to the manufacturer and providing an estimate to the

Art Unit: 3627

buyer to answer if a condition for manufacturing the product is satisfied. Examiner further notes that one of the manufacturing conditions is clearly cost as required by Applicant's claims.

Dudle et al. does not teach that the product manufactured is an electronic product, specifically a semiconductor. However, Applicant discloses on page 1 of the specification that the ordering and manufacturing of custom electronic products, specifically semiconductors consumes much time and involves considerable costs. Dudle et al. teaches the same exact problem with the custom ordering of forms. In particular, the customer interaction process can be arduous and time-consuming because of the multitude of options to be considered (column 1; lines 42-45).

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system and method of Dudle et al. in order to facilitate the custom ordering of electronic products, as disclosed by Applicant in order to reduce the time and cost associated with such an order.

Examiner notes the Dudle et al. reference is in the same field of endeavor as Applicant's invention, namely custom-manufacturing and ordering. However, even if it is determined that the field of endeavor is different, the Dudle et al. reference is still consider analogous art as it is reasonably pertinent to the particular problem with which the Applicant is concerned.

Conclusion

Applicant's arguments with respect to claims 1, 3-8, 10-15 and 17-32 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3627


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer
Examiner
Art Unit 3627

jak


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